

REMARKS

In the Office Action, the Examiner rejected claims 1-22. By this Response, Applicants amend claim 10, cancel claim 15, and add new claims 23-27. These amendments do not add new matter. Currently, claims 1-14 and 16-27 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and following remarks, Applicants respectfully request allowance of all pending claims.

Rejections under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 5, 14 and 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. The Applicants respectfully traverse this rejection.

Although the Examiner may take exception to the terms used in the claims, the patentee may be his own lexicographer. *Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513 (7th Cir. 1971), *aff'd* 613 F.2d 775 (7th Cir. 1979), *cert. denied*, 446 U.S. 939 (1980). The Examiner is also reminded not to equate breadth of a claim with indefiniteness. *In re Miller*, 441 F.2d 689, 169 U.S.P.Q 597 (CCPA 1971). As set forth in Section 2173.02 of the Manual of Patent Examining Procedure, the focus of 35 U.S.C. § 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. *See* M.P.E.P. § 2173.02. The definiteness of claim language must be analyzed, not in vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *See id.*

The Applicants submit that the present claims clearly and definitely set forth the boundaries of the claimed subject matter. For example, one of ordinary skill in the art would readily understand the boundaries of claims 5, 14 and 19 based on the specification of the present application among other factors. The specification of the present application specifically discloses that a "graphical user interface 'GUI' allows the individual to interact with the device through an input device, such as a keyboard or mouse." Application, paragraph 0001. The specification of the present application further discloses a "digitizer panel 40 may be disposed below the glass panel 22" and "the pointer mechanism 26 interacts with the digitizer panel 40 and an associated graphical user interface (GUI) 41 for coordination, selection, writing and other user-interaction via information provided through the display surface 20." Application, paragraphs 0014 and 0015. In view of these passages among others, one of ordinary skill in the art would readily understand the boundaries of the claimed subject matter.

For these reasons among others, the Applicants respectfully request withdrawal of the rejections under Section 112, Second Paragraph.

Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-6, 9-14 and 16-22 as anticipated by Depew et al. (U.S. Patent No. 6,215,476, hereinafter the "Depew" reference) and claims 1, 3-7, 9, 16 and 18-22 as anticipated by Dunn et al. (U.S. Patent Publication No. 2004/0027392, hereinafter the "Dunn" reference). Applicants respectfully traverse these rejections.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the identical invention "in as complete detail as contained in the ... claim" to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Further, the pending claims must be given an interpretation that is reasonable and consistent with the *specification*. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969) (emphasis added); M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is "the primary basis for construing the claims." See *Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. See *id.*

Interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. See *In re Corthright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. "The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation." See *Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, -1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*, No. 03-

1269, -1286, at 16). The Federal Circuit has made clear that derivation of a claim term must be based on "usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art." *See id.*

First Rejection

In the Office Action, the Examiner rejected claims 1-6, 9-14 and 16-22 as anticipated by the Depew reference. Applicants respectfully traverse this rejection.

Claims 1, 16 and 21

The Examiner's rejection is flawed for a number of reasons. The cited reference does not teach or suggest that "the top surface and the perimeter edge form an uninterrupted and smooth transition," as recited by independent claim 1, "a smooth transition between the display panel and the portable computer housing," as recited by independent claim 16 or that "a smooth transition exists between the top display surface and the edge such that the display is flush with the edge," as recited by independent claim 21. (Emphasis added.)

In contrast, the Depew reference teaches a display assembly 100 with a top glass 102 both recessed into a front housing 104 and spaced away (e.g., a substantial gap) from a front housing 104. Depew, Fig. 7. Notably, the Depew reference discloses in Fig. 7 that the top glass 102 has a smaller surface area and depth than the recessed portion of the front housing 104 that holds the top glass 102. In other words, the transition between the top glass 102 and the front housing 104 is neither smooth nor uninterrupted. Thus, the Depew reference could not possibly teach *all* of the features of claims 1, 16 and 21. In view of these deficiencies, the cited reference cannot anticipate claims 1, 16 and 21 or the claims that depend therefrom.

Claim 10

The Examiner's rejection is flawed for other reasons as well. The Depew reference does not teach or suggest "a shock absorbent pad disposed underneath the glass panel," as recited by independent claim 10. (Emphasis added.) In sharp contrast, the Depew reference teaches a top glass 102 without an intermediary member interposed between the top glass 102 and a front housing 104. In fact, the Depew reference does not even disclose a pad, let alone a pad underneath a glass panel. Thus, the Depew reference could not possibly teach *all* of the features of claim 10. In view of these deficiencies, the cited reference cannot anticipate claim 10 or the claims that depend therefrom.

Second Rejection

In the Office Action, the Examiner rejected claims 1, 3-7, 9, 16 and 18-22 as anticipated by the Dunn reference. Applicants respectfully traverse this rejection.

Request Removal of Commonly Assigned Reference under 103(c)

Regarding the Dunn reference, Applicants respectfully stress that Dunn et al. (U.S. Patent Publication No. 2004/0027392) should be removed from consideration in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l), because the present application and Dunn et al. (U.S. Patent Publication No. 2004/0027392) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, Hewlett-Packard Development Company, L.P.. Accordingly, Applicants respectfully request the Examiner remove Dunn et al. (U.S. Patent Publication No. 2004/0027392) from consideration. After the Dunn reference is removed according to 35 U.S.C. § 103(c), the Examiner's rejection based on Dunn et al. (U.S. Patent Publication No. 2004/0027392) is moot.

For these reasons, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102.

Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 8 and 15 as obvious over the Depew reference in view of White et al. (U.S. Patent No. 6,352,152, hereinafter the "White" reference). Applicants respectfully traverse this rejection.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Claim 8

The rejection of claim 8 under Section 103 is defective for at least the reasons set forth above with respect to the rejection of claim 1 under Section 102. Specifically, as explained above, the Depew reference does not disclose or suggest that the “top surface and the perimeter edge form an uninterrupted and smooth transition,” as recited by independent claim 1. Moreover, the White reference fails to cure this deficiency. The White reference discloses a touch panel 212 that is recessed into an upper housing shell 204. White, Fig. 3A. As indicated by Figure 3A, the upper housing shell 204 overlaps the touch panel 212. Additionally, the gasket 314 spaces the upper housing shell 204 away from the touch panel 212. *See id.* Thus, the transition between the touch screen 212 and the upper housing shell is not smooth, as there is a substantial step between the outer surface of the upper housing 204 and the top surface of the touch screen 212. *See id.* Accordingly, the Depew reference and the White reference, taken alone or in hypothetical combination, cannot render claim 8 obvious.

Moreover, the Depew reference and the White reference, taken alone or in hypothetical combination, absolutely do not teach or suggest “a pad disposed between the glass panel and the housing to absorb shock,” as recited by claim 8. As indicated by Figure 7, the Depew reference teaches a top glass 102 in direct contact with a top housing 104. Indeed, the Examiner noted in the Office Action that the Depew reference does not teach a pad between the glass panel and the housing to absorb shock. Office Action, page 4. Further, the White reference does not teach or suggest these features of claim 8. The White reference discloses a “[t]ouch panel 212 [that] is supported over display 114 by engagement between shock absorbing frame 300 and gasket 314.” White, col. 15, ll. 26-29. The gasket 314 is clearly not a pad, as recited by claim 8. Indeed, the shock absorbing frame 300 absorbs shock in the device taught by White, not the gasket 314. Thus, for this reason also, the Depew reference and the White reference, taken alone or in hypothetical combination, cannot render claim 8 obvious.

Claim 10

The Depew reference and the White reference, taken alone or in hypothetical combination, fail to teach or suggest *all* the features of claim 10. Independent claim 10 recites, “a shock absorbent pad disposed underneath the glass panel.” However, as noted above, neither the Depew reference nor the White reference, alone or in combination, teach or suggest a pad. Thus, these references cannot render claim 10 obvious.

Moreover, the Depew reference and the White reference, taken alone or in hypothetical combination, fail to teach or suggest “a shock absorbent pad disposed underneath the glass panel.” As neither of these references disclose or suggest a pad, they could not possibly disclose or suggest a pad underneath a glass panel. Indeed, the cited references require several non-obvious, and substantial, modifications to reach the subject matter of the present claims. Applicants note that the gasket 314 taught by the White reference is above the LCD 114 and the touch panel 212. White, Fig. 3A. Thus, even if, hypothetically, and contrary to the teachings of both references, the gasket 314 were replaced with a pad, the pad would still not be underneath a glass panel. Accordingly, for this reason also, the Depew reference and the White reference, taken alone or in hypothetical combination, absolutely cannot render claim 10 or its dependent claims obvious.

For these reasons among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

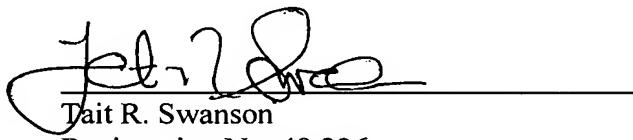
Serial No. 10/687,187
Amendment and Response to
Office Action Mailed September 27, 2005

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: December 21, 2005



Tait R. Swanson
Registration No. 48,226
(281) 970-4545

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400